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Serial No.: 10/756,995
Art Unit: 1744REMARKSA. New Matter Objection/Rejection

The Examiner objected to paragraph 18 of the specification under 35 U.S.C. § 132(a) and rejected claim 7 under 35 U.S.C. § 112, first paragraph as including new matter due to the inclusion of the term "safety recess." While the Applicant respectively does not agree with this finding, the reference to "safety recess" has been removed from the specification by the above amendments and claim 7 has been canceled thereby obviating its rejection.

B. Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1-5 and 7-9 under 35 U.S.C. § 112, second paragraph. The Examiner's appears to have rejected independent claim 1 for being an inconsistent subcombination claim. Claim 1 has been amended ("said device comprising") so that it more clearly only claims the subcombination of the device and not a combination of the device and probe pins of a probe head assembly. Accordingly, as noted by the Examiner, the probe pins have not been positively recited in claim 1. Rather, the probe pins have been referred to only functionally. As amended, claim 1 is now believed to be in condition for allowance. For the Examiner's reference, the Applicant referred to the attached Patent Office memorandum in structuring claim 1.

C. Rejections Under 35 U.S.C. § 102(b)

The Examiner rejected claims 1-3, 8, and 9 under 35 U.S.C. § 102(b) as anticipated by Japanese Patent No. JP2002177895, issued to Masahiko ("Masahiko"), rejected claims 1-3, 8, and 9 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,537,706, issued to Baker ("Baker"), and rejected claims 1 and 5 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,199,238, issued to Huang ("Huang").

As currently amended, independent claim 1 is limited to a cleaning cartridge that is configured such that the upper surface of the cleaning cartridge and the top surface of the absorbent pad are offset from one another by a predetermined distance that is greater than zero. Support for the amendments to claim 1 is found in FIG. 5 as originally submitted, paragraph 15

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as amended, and paragraph 19 as originally submitted. FIG. 5 shows a predetermined distance that is greater than zero. Paragraph 19 lists as an advantage of the invention that “[t]he probe card body is kept dry so no contaminants are introduced on or into it.” Accordingly, the predetermined distance must be greater than zero or the absorbent pad containing contaminants will contact the probe card body. None of the cited references teach or suggest such a limitation.

Further, a device according to claim 1 is limited to one having a predetermined distance that defines a depth that the probe pins penetrate the absorbent pad when a surface of the probe head assembly is brought into contact with the upper surface of the cleaning cartridge. None of the cited references teach or suggest such a limitation. Masahiko fails to teach such a limitation and in fact relies on a dial mechanism to determine the depth that probe pins penetrate. Accordingly, claim 1 is believed to be in condition for allowance. For at least the same reasons, the balance of the claims, which depend from claim 1, are also believed to be in condition for allowance.

D. Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as obvious over the Masahiko or Baker references in view of an obvious design choice to use polyvinylchloride. The Examiner also rejected claims 5 and 7 under 35 U.S.C. § 103(a) as obvious over Masahiko in view of U.S. Patent No. 5,240,339, issued to DeForest et al.

Claim 1 is now believed to be in condition for allowance. For at least the same reasons, claims 4, 5, and 7, which depend from claim 1, are also believed to be in condition for allowance.

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E. Summary

In the present Office Action, claims 1-5 and 7-9 were examined. Claims 1-5 and 7-9 are rejected. Claim 1 is amended and claim 7 is canceled. Claims 1-5, 8, and 9 are presented for consideration.

Based on the remarks above, Applicants submit that none of the references, alone or in combination, anticipates or makes obvious the invention as presently claimed and that the application is now in condition for allowance. Therefore, Applicants respectfully request reconsideration and further examination of the application and the Examiner is respectfully requested to issue a Notice of Allowance at the earliest possible date.

If the Examiner has any questions or believes that a discussion with Applicants' attorney would expedite prosecution, the Examiner is invited and encouraged to contact the undersigned at the telephone number below.

Please apply any credits or charge any deficiencies to our Deposit Account No. 23-1665.

Respectfully submitted,
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DATE: September 13, 1988

TO: Examiners
Group 330

FROM: *J. J. Lane*
Director, SPEs
Group 330

SUBJECT: Treatment of Certain Combination/Subcombination
Claims

This memorandum is a statement of Group 330's manner of treating claims where the subject matter set forth in the preamble of the claim is not consistent with the limitations recited in the body of the claim.

A typical example is a claim in which the preamble clearly indicates that a subcombination is being claimed, e.g., "a plant support for use with a ceramic flower pot, the plant support comprising..." This language would lead the examiner to believe that the applicant intends to claim only the subcombination of a "plant support," the flower pot being only functionally recited. This presents no problem as long as the body of the claim also refers to the pot functionally, such as, "adapted to extend from the pot" or "for attachment to said pot."

The problem arises when the pot is positively recited within the body of the claim, such as, "said plant support extending from the rim of said flower pot" or "said plant support attached to said flower pot." In this case there is an inconsistency within the claim. The preamble indicates subcombination, while in the body of the claim in at least one instance there is a positive recital of structure indicating that the combination of a pot and a support is being claimed. The examiner cannot be sure if applicant's intent is to claim merely the support or the support in combination with a pot.

Claims of this type may be handled as follows:

- 1) Reject the claim under 35 USC 112, second paragraph, explaining that there is an inconsistency between the language in the preamble and certain portion or portions in the body of the claim, thereby making the scope of the claim unclear. Require that the applicant clarify what the claim is intended to be drawn to, i.e., either the support alone or the combination of support and pot, and that he make the language of the claim consistent with his intent.

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- 2) In formulating a rejection on the merits, state that you are considering that the claim is drawn to the combination and reject it accordingly. If a claim recites even one positive recitation of the combination, in this instance the pot, then the art used in the rejection must disclose the entire combination as claimed and not just the support.
- 3) In the event that the claim considered as a combination is allowable over the art, the claim will be rejected only on the basis of the 112, second paragraph rejection. If applicant then indicates by amendment that the combination claim is his intention, the language in the preamble should be made consistent with the language in the body of the claim and the claim allowed.
- 4) If applicant indicates that the intent is to claim only the subcombination, the body of the claim must be amended to remove any positive recitation of the combination. If applicant fails to so amend, the 35 USC 112 rejection should be repeated and made final. The claims should also be treated on the merits as a subcombination claim in view of the statements of record.